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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,040	07/11/2003	Eiji Itoi	SOHMEI.PT1006	4117

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EXAMINER

WIEKER, AMANDA FLYNN

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,040

Applicant(s)

ITOI, EIJI

Examiner

Amanda F. Wieker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/7/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species B in the reply filed on 15 December 2004 is acknowledged. The traversal is on the ground(s) that examining all species claimed would not pose a serious burden on the examiner. This is not found persuasive because Species A is directed to and claims a deformable and adjustable angle at which the arm is held while being immobilized, while Species B is directed to and claims a static immobilization member, which holds the arm at a single position during immobilization. Such features result in a divergent search, and an administrative burden.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-3 and 6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 15 December 2004.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “flank sides” claimed in claim 4, and the subject matter of claim 5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

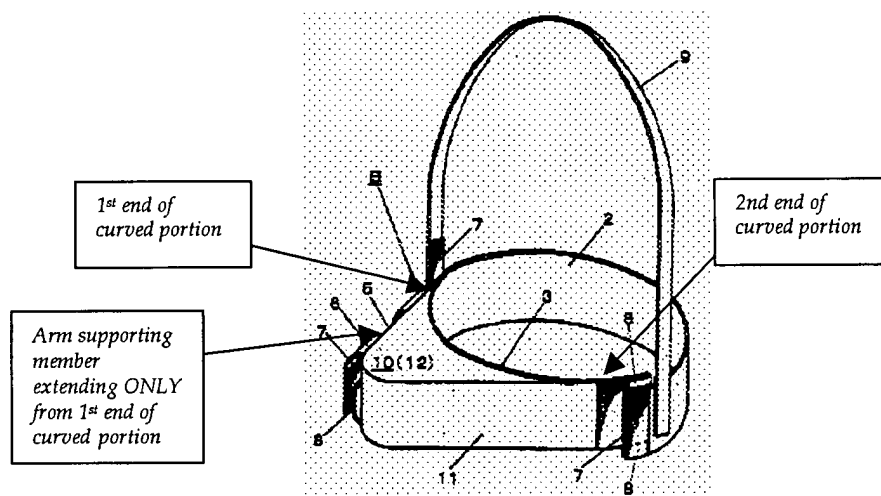
Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The abstract of the disclosure is objected to because the phrase “An embodiment of the invention is” can be implied and should be removed. Correction is required. See MPEP § 608.01(b).

6. The specification is objected to as follows:

- On page 7 of the specification, Applicant states that the arm supporting side face (5) “is extended forward from both ends of the curved portion 3”. This appears to be contrary to the relevant drawings provided. See the marked up Figure below. The arm supporting side face extends forward from one end of the curved portion only. The arm supporting side face does not extend forward from the second end of the curved portion at all. It is unclear what this language, in light of the drawings, means.



- Also on page 7, the description of the arm supporting side face as extending forward from a “flank side”, with an inclined surface extending from “the other flank side”, is unclear. It is unclear to the examiner what “flank side” is referred to; whether it is a “flank side” of the user, a “flank side” of the device, or some other “flank side” altogether. Neither the specification nor the drawings provide any further clarification.

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Correction is required.

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not disclose or provide antecedent basis for the subject matter of claim 5 (or of withdrawn claim 6).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is indefinite because it is unclear what is meant by the limitation stating that the arm supporting side face is “extending forward from both ends of the curved portion”, as explained above. The claim will be interpreted as it is shown in the drawings. Consequently this limitation will be considered as: “extending forward from a first end of the curved portion”.

In addition, lines 8-11 of claim 4 are unclear and indefinite. As described previously, it is unclear what “flank side” is referred to here. The examiner understands the angle of inclination at which the arm supporting side face extends, as shown in Figure 7. What is unclear is the “plurality of flank sides [what plurality of sides? Where are they?] with respect to a surface [what surface?] extended forward in parallel with a flank [of what?]” and the inclined surface mated to the arm supporting side face from another “flank side”. It is unclear what these flank sides belong to- the user, the device, or something else. It is unclear what surface these flank

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sides are parallel to. The claim will be interpreted as best understood by the examiner. This limitation will be treated as: "to create an angle of inclination within an range of 5°~10° outward from at least one of a plurality of flank sides of the user, with respect to a surface extended forward in parallel with a flank side of the user, and an inclined front face mated to said arm supporting side face from the other flank side of the user".

Claim 5 incorporates the indefiniteness of claim 4 and is therefore rejected.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Publication Number 2001-299789 to Tatsuya et al.

Tatsuya et al. disclose a shoulder dislocation acute-phase immobilization orthosis as shown in Figures 4a and 4b comprising:

a roughly triangular support block (1) formed of a lightweight hard synthetic resin material (such as styrene foam), with a width approximately greater than that of the forearm (see width of forearm versus width of support block in Figures 4a-b), comprising:

a curved portion (D) having two ends, which follows the shape of an abdominal part of a body;

an arm supporting side face (F) of approximately a forearm length (see length of forearm versus length of support block in Figures 4a-b), which is extended forward from a first

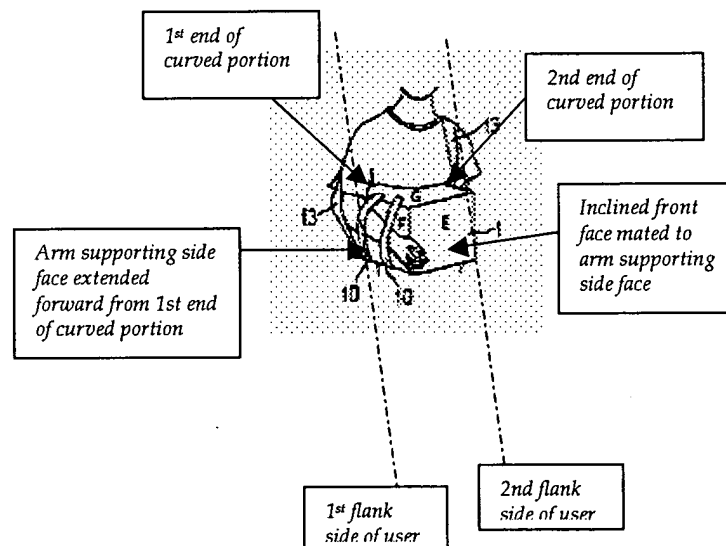
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end of the curved portion to create an angle of inclination within an range of approximately 5° ~ 10° outward from at least one of a plurality of flank sides of the user, with respect to a surface extended forward in parallel with a flank side of the user, and an inclined front face (E) mated to said arm supporting side face from the other flank side of the user;

an arm supporting member (10) for immobilizing the forearm, provided on said arm supporting side face (F); and

a wrap-around belt (16) made of a flexible material, provided with a surface fastener (19/20) for fitting said support block (1) to the trunk part of a body. Applicant does not disclose any criticality to the width of the belt being that of the support block.

Therefore, it would have been obvious to have provided the belt disclosed by Tatsuya et al., with a width equal to that of the support block, or any other desired width, to achieve a secure fitting of the support block to the user.



12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsuya et al. in view of U.S. Patent Number 4,896,660 to Scott.

Tatsuya et al. disclose the previously described shoulder dislocation acute-phase immobilization orthosis comprising a support block with an arm supporting side face having an arm-supporting member (10) for immobilizing the forearm. Tatsuya et al. do not specify that the arm-supporting member can be releasably fixed to the arm supporting side face.

Scott discloses a shoulder dislocation immobilization orthosis comprising a support block (14, 18) with an arm supporting side face (48) having an arm-supporting member (62) for immobilizing the forearm. Scott specifies that the arm-supporting member be releasably secured to the support block by pile-and-loop releasable fasteners, to allow releasable securement of the arm to the support block.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the orthosis disclosed by Tatsuya et al., wherein the arm supporting member is releasably secured to the support block, as taught by Scott, to allow releasable securement of the arm to the support block.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wiekert whose telephone number is 571-272-4794. The examiner can normally be reached on Monday-Thursday, 8:30 - 6:00 and alternate Fridays.

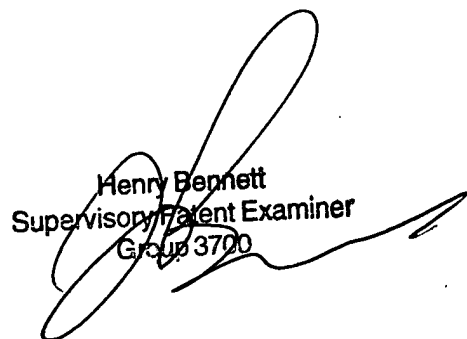
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Amanda F. Wieker
Examiner
Art Unit 3743

afw


Henry Bennett
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